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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Malcolm Ronald Hebblewhite

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EXAMINER

SOREY, ROBERT A

ART UNIT

PAPER NUMBER

3626

MAIL DATE

DELIVERY MODE

04/30/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/560,963	Applicant(s) HEBBLEWHITE ET AL.	
	Examiner ROBERT SOREY	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/13/2006, 12/08/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-4** are rejected under 35 U.S.C. 101 because, though Applicant indicates that the claim is directed towards a monitoring process performed on a computer, there are no positively recited steps performed by the computer to indicate said process; hence, there is no method.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1 and 3** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. As per claim 1, Applicant teaches "SDB", "BMI", "AHI", "AI", and "CPAP", but does not fully elaborate the acronym's full meaning. To eliminate any chance for confusion, the first occurrence of each acronym should be completely spelled out and follow by the acronym in parenthesis. Claim 3 is rejected for similar reasons.

Examiner's Note on Nonfunctional Descriptive Material

6. As per claims 1 and 3, the Examiner has placed little weight on what data is stored and displayed on the computer since the data itself has no material effect on the

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storing and displaying steps. The method did not alter or change the information received by the computer; therefore, the data itself (i.e., data associated with BMI, AHI, AI, usage, and CPAP titration) is nonfunctional descriptive material and is not given weight for the purposes of examination. Applicant's claims simply teach storing and displaying data, which has long been taught. Regardless, the Examiner has cited portions of the prior art that read on the nonfunctional descriptive material in the claims. See: Ex parte Herman Mathias, Appeal No. 2005-1851, Application No. 09/612788; and Ex parte James Prescott Curry, Appeal No. 2005-0509, Application No. 09/449237.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 1-4** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent Application Publication 2003/0208465 to Yurko.

9. As per claim 1, Yurko teaches a method for monitoring SDB management on a computer, the method comprising the steps of:

--*storing data on the computer* (Fig. 1)(see: Yurko, paragraph 32-34 and 43-49, is met by data stored in a database on a computer), *the data being associated with a time period of interest* (Fig. 8A)(see: Yurko, paragraph 28, is met by device usage dates;

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paragraph 34 and 68, is met by start date and end data) *and relating to BMI* (Fig.

10)(see: Yurko, paragraph 29 and 74, is met by weight and body mass index (BMI)) *and one or more of AHI, AI, Usage and CPAP titration* (Fig. 23A-23E)(see: Yurko, paragraph 29, 63, 69, 74, and 111-112, is met by CPAP daily usage and compliance); *and*

--displaying the stored data in graphical form for a selected time period (Fig. 1; and Fig. 23A-23E)(see: Yurko, paragraph 43-49, is met by computer interface for data presentation; and paragraph 111-112, is met by reports).

10. As per claim 2, Yurko teaches the invention substantially as claimed, see discussion of claim 1, and further teaches:

--wherein the selected time period is adjustable (Fig. 8A; and Fig. 23B)(see: Yurko, paragraph 28, is met by device usage dates; paragraph 34 and 68, is met by start date and end data being adjustable; and paragraph 112, is met by exclusion days).

11. As per claim 3, Yurko teaches a method for monitoring SDB management on a computer, the method comprising the steps of:

--storing data on the computer (Fig. 1)(see: Yurko, paragraph 32-34 and 43-49, is met by data stored in a database on a computer), *the data being associated with a time period of interest* (Fig. 8A)(see: Yurko, paragraph 28, is met by device usage dates; paragraph 34 and 68, is met by start date and end data) *and relating to body mass* (Fig. 10)(see: Yurko, paragraph 29 and 74, is met by weight and body mass index (BMI)) *and one or more of AHI, AI, Usage and CPAP titration* (Fig. 23A-23E)(see: Yurko, paragraph 29, 63, 69, 74, and 111-112, is met by CPAP daily usage and compliance); *and*

--*displaying the stored data in graphical form for a selected time period* (Fig. 1; and Fig. 23A-23E)(see: Yurko, paragraph 43-49, is met by computer interface for data presentation; and paragraph 111-112, is met by reports).

12. As per claim 4, Yurko teaches the invention substantially as claimed, see discussion of claim 3, and further teaches:

--*wherein the selected time period is adjustable* (Fig. 8A; and Fig. 23B)(see: Yurko, paragraph 28, is met by device usage dates; paragraph 34 and 68, is met by start date and end data being adjustable; and paragraph 112, is met by exclusion days).

Examiner's Note

13. The article "Detection of Continuous Positive Airway Pressure compliance in a Group of Chinese Patients with Obstruction Sleep Apnea" (Hui et al., CHEST, Vol 120, No 1, 07/2001, pp 170-176), cited on Applicant's 01/13/2006 IDS, was found to be of significant relevance, though it was not used for the purposes of rejection. Specifically, on page 2 (original publication page 170), under the heading of *Other Parameters of Interest*, Hui teaches analyzing variables, such as BMI and AHI, for correlation with CPAP compliance at intervals such as 1 and 3 months.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 6,581,595 to Murdock teaches using a CPAP titration device in connection with a patient's weight reduction or weight maintenance program.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT SOREY whose telephone number is

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(571)270-3606. The examiner can normally be reached on Monday through Friday, 8:30AM to 5:00PM (EST).

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Gilligan can be reached on (571)272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. S./
Examiner, Art Unit 3626
20 April 2009

/Robert Morgan/
Primary Examiner, Art Unit 3626